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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

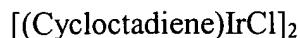
APPLICANT(S) : John Hartwig, et al.
SERIAL NO. : 10/527,899
FILED : March 16, 2006
FOR : Enantioselective Amination and Etherification

GROUP ART UNIT : 1793
Examiner : James E. McDonough

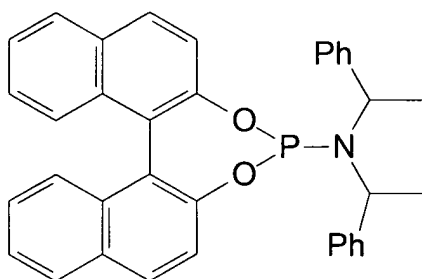
Mail Stop: Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia, 22313-1450

**Election of Invention in Response
to Restriction Requirement**

In response to the Examiner's correspondence dated March 5, 2009 pursuant to the Examiner's restriction requirement in the above-referenced patent application, Applicants provisionally elect with traverse to prosecute the invention of group I, namely claims 1-11, which are drawn to a catalyst. In addition, Applicants elect with traverse to prosecute a single species falling with group I, where M is Ir, X=Cl, S= cyclooctadiene, the chemical precursor has the structure:



and the phosphoramidate ligand has the chemical structure:



and is cyclometallated .

Claims 1-5, 7-8 and 9-11 are readable on the elected species.

Notwithstanding Applicants' species election, Applicants respectfully traverse the Examiner's requirement for restriction. Applicants respectfully request the Examiner reconsider his restriction requirement in its entirety. Applicants respectfully submit that prosecution of all of previously elected claims without regard to the imposed restriction will allow the Examiner to examine all claims without being subjected to an undue burden as discussed hereinbelow.

According to M.P.E.P. §803, restriction by the Examiner of patentably distinct inventions is proper if the claimed inventions are independent and a *serious burden* would be placed on the Examiner if restriction was not required. Applicant respectfully submits that the presentation of the originally filed claims would not place such a serious burden on the Examiner as to require restriction. All of the originally restricted claims are directed to patentably distinct chemical compounds/compositions or methods of using these compounds/compositions which would not impose a heavy burden of examination on the part of the Examiner.

Thus, it is Applicants' view that any search the Examiner would need to conduct in examining the instant application of all the claims would not be unduly burdensome. That would not be to say that the examination would not be rigorous or even time-consuming, but that such effort would not meet the requirements of MPEP§803. It is respectfully submitted that the

examination of all of the originally filed claims in the instant application would not place such a serious burden on the Examiner as to require restriction.

Applicants understand the general policy considerations for the Patent Office's requirement for restriction in certain instances. In this instance, however, those considerations do not weigh in favor of restricting the inventions here. In determining the appropriateness of restriction, one must also consider the countervailing consideration that, in each instance, Applicants wish the Patent Office examine their patent application with a certain degree of "administrative efficiency" and wish to have patent claims issue which reflect the breadth of their invention.

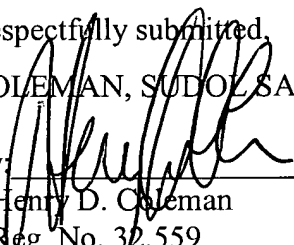
Applicants respectfully submit that the originally filed claims are sufficiently narrow to allow the Examiner to determine patentability without being subjected to the serious burden referred to in M.P.E.P. §803. Consequently, Applicant respectfully requests that the Examiner withdraw the restriction requirement in its entirety.

Alternatively, in the interest of administrative efficiency, Applicants respectfully request that the Examiner extend consideration to examining claims 1-11 without further limiting such examination to the single species as set forth in the figure above, inasmuch as 10 of the 11 claims are readable on the elected species and examining one addition claim (claim 6) would not make the examination of claims 1-5 and 7-11 significantly more difficult compared to the administrative efficiency which would result from the prosecution of all of the claims of group I.

It is noted here that all of the claimed compositions represent variations of related, though patenably distinguishable catalysts, which compounds have a common utility. Examination of all 11 claims of group I will provide a measure of administrative efficiency reflective of the nature of Applicants' invention. Applicants therefore respectfully request the Examiner to withdraw her restriction requirement at least for claims 1-11 of invention group I.

The Examiner is cordially requested to call the undersigned attorney if the Examiner believes that a telephonic discussion may materially advance the prosecution of the instant application in any way.

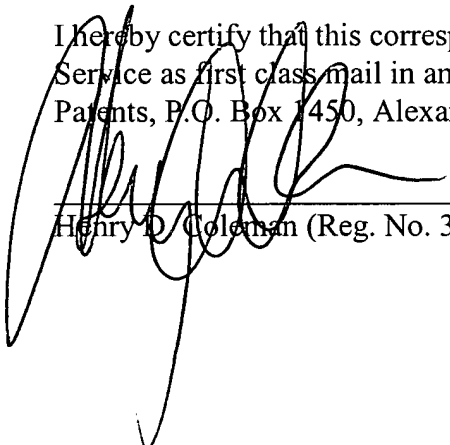
Respectfully submitted,
COLEMAN, SUDOL SAPONE, P.C.

By: 
Henry D. Coleman
Reg. No. 32,559
714 Colorado Avenue
Bridgeport, Connecticut
(203) 366-3560

Dated: March 31, 2009

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia, 22313-1450, dated April 2, 2009.


Henry D. Coleman (Reg. No. 32,559)



Restriction Requirement
S.N. 10/527,899
Y03-103US